REMARKS

Applicants confirm the election of the invention of group 1, claims 1-38. Claims 39-41 are hereby cancelled without prejudice. Applicants reserve the right to pursue these non-elected claims in (a) future divisional application(s).

Claims 14 and 31 have been amended to correct the minor grammatical errors noted by the Examiner. Claims 27 and 28 have been amended to correct an antecedent basis error.

Reconsideration of the rejections of claims 13, 19, and 35 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,167,376 to Ditzik (hereinafter Ditzik) is respectfully requested.

The Examiner takes the position that:

> "Ditzik discloses a system that (sic -- has) an 'input port for receiving first information from the network,' where the system can receive voice data and hand written data (See Figs. 3 and 4, telephony means 8 and external comm. [m]eans 4; column 6 lines 1-20). The system also has a 'signature pad permitting a user to enter handwritten communication for transmission over the network' (See Figs. 3 and 4, pen/stylus input means 10; column 6 line 63-column 8 line 30); wherein the telephony means or external comm. means serves as the 'port for coupling handwritten communication-related signals to the network' (See Figs. 3 and 4; column 6 line 63-column 8 line 30)."

The official action, page 4, lines 12-20.

Claim 13 specifically recites "an instrument for testing a CATV network." The computer system disclosed in Ditzik is a voice and handwriting recognition system. It is not capable of *testing* a CATV network, or anything else for that matter. Quoting from Ditzik:

> "FIG. 4 shows a representation of the computer system's display screen, with a new unique computer telephony application program. In this disclosure, telephony includes telephone-like connections to communication networks such as telephone, Internet, and cable networks. This system makes use of pen/stylus input means and speech input means, with both handwriting and speech recognition functions enabled (turned on) at the same time. The screen shows the name of the caller (via a caller ID function), the name of the answering party, date and time. The audio signal for the speech may sent to a speaker so that the user ca[n] listen [to] the speech information; the user may then make one or more decisions on the system setup options desire, as shown in menus 39. Speech data from both the caller and local user may captured, digitized, processed, recognized and displayed on the screen at near

realtime. Since speech recognition is not perfect, recognition errors and omissions may be displayed along with the correctly recognized text. Recognition of the caller speech over the phone lines may be slightly worse than the local user's speech. As these recognition errors are observed by the viewer, he/she may use the pen or stylus to correct these speech recognition errors or omissions by direct hand writing on a writing pad or on the screen. The speech recognition errors on the screen are represented in the figure by corrections 38, 38A, 38B, 38C, 38D, and 38E. The user may quickly and efficiently make editing marks (inking) with the pen, as shown. The pen marks and handwriting may be recognized immediately, but could be displayed after a delay interval selected by the user. The user, viewing the text of the two-way conversations, can make editing marks without losing concentration on what is being said during the telephone call or audio input. In an alternative embodiment, the user may have the option to delay the display of recognized handwriting data until the user provides a command action, perhaps by click an icon or menu item. The software application may also include code to provide means to quickly add one or more graphic frames 34. The user can draw and write in the frame, to record graphical representations 40 of what is being said by either party. Graphic frames can be scaled and sized via the graphic handles 36. Long conversations yielding much text can be accommodated by automatically scrolling off text from the screen. However, such data may remain stored in memory such in a data storage system 18. Manual scroll bars may be provided. Text can be made to wrap around the graphics frame 34 as in typical word processor or draw programs.

"The operating system may support multiple independently controlled cursors to make the graphical user interface easier and faster to use. The setup of the program may have several options, as shown on the left side of FIG. 4. Many other typical computer application features may be included, as are well known to those skilled in the art. Although many tasks can be processed with little observable delay, other calculations and tasks may be compute intensive. There may be some delay in the display of speech and handwriting recognition text results, even with the help of DSP co-processors. However, the delays in the 500 ms range--may be small enough not to cause a human factors problem with respect to the user. Other delays may exist in pen inking, shape recognition or gesture recognition. When two or more of these systems are connected via an external communication system, there may be inherent communication delays. However, depending on the type and speed of the external communication means, response times should be made small as not be objectionable. The system may feature a delay option for the handwriting recognition, so that the user can view his or her pen input electronic ink for the

> screen or multiple screens, before the recognition data is displayed. A portion of the screen or screens may be displayed instead of the entire recognized data. The system may have telephone connection (POTS, ISDN, ASDL, HSDL, ATM, etc.), cable TV interface, Internet connection, and/or wireless communication. Interlaces to the network may be analog or digital or a combination. The inventions herein are compatible with video and data conferencing means. Many clever and useful combinations of PC and telephony applications can be embodied to provide new collaboration, groupware conferencing and remote communication uses."

Ditzik, col. 7, line 19-col. 8, line 30.

Ditzik describes an integrated system for recognizing spoken and handwritten words and transcribing the recognized spoken or handwritten words. While it may be the case that the computer system of Ditzik may be electronically coupled to a CATV network, the computer system of Ditzik is not provided "for testing a CATV network." MPEP § 2111.02 recognizes that "[i]ntended use recitations and other types of functional language cannot be entirely disregarded" noting that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." The corollary, of course, is that if the prior art structure is not capable of performing the intended use, then it does not meet the claim. And Ditzik is not capable of performing the intended use. Nowhere in Ditzik is there any disclosure or even any suggestion that the computer system of Ditzik is capable of testing a CATV network as recited in independent claim 13. As such, Ditzik does not anticipate Applicants' invention as recited in claim 13. Thus, claim 13, and claims 19 and 35 which depend directly from claim 13, are not anticipated by Ditzik.

Reconsideration of the rejection of claims 1-7, 25, 26, 29-34, 36 and 38 under 35 U. S. C. § 103 based upon the combination of Budinger U. S. Patent 6,802,032 (hereinafter Budinger) and Chappell U. S. Patent 6,425,132 (hereinafter Chappell) is respectfully requested.

The Examiner relied upon Budinger to disclose

> "an instrument for 'testing a CATV network' (See Fig. 1, handheld computer 50A or 50B; column 4 lines 30-35). The computer has 'an input port for receiving first information from the network' where the computer can receive status and error messages from the equipment that are part of the network (See Figs. 1 and 2; column 3 lines 19-35 and column 7 line 61-column 8 line 5). The handheld computer furthermore has a 'user interface' to enter commands (See Fig. 3) and the computer is coupled to the network through a serial port or 'a serial port for coupling to the network' (See Figs. 1 and 2;

column 7 lines 8-20). However, Budinger does not disclose creating 'second information for communication over the network.'"

The Examiner relied upon Chappell to disclose

> "a system for testing a CATV system (See Fig. 1). Chappell discloses a mobile field client that is able to connect to the CATV network. The technician is able to test upstream communications by entering data into the field client that will be sent to the headend or 'second information for communication over the network'. The results from the message are sent back to the field client in order for the technician to determine the condition of the CATV system (See column 5, line 59-column 6 line 30). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the handheld computer disclosed by Budinger to perform testing on the reverse path by creating 'second information for communication over the network", as taught by Chappell, in order to increase the testing capabilities of the handheld computer thereby providing the user with more tools to troubleshoot the network with."

The official action, page 5, line 11-page 6, line 8.

In Budinger,

> "Further illustrated in FIG. 1 is the connection of hand-held computers 50A and 50B to portions of cable system 10 in order to perform testing, diagnostics or configuration. Hand-held computer 50A is connected to CMTS 12 via connection 52A, which is preferably wireless. Similarly, hand-held computer 50B is connected to CM 16 via connection 52B, which is preferable wireless. The hand-held computers 50A and 50B download CLI commands over connections 52A and 52B, respectively, to CMTS 12 and CM 16, respectively. Examples of CLI commands are set forth in "Cable Access Router User Guide", 3Com Corporation Part No. 1.024.1740-00, published October 1998, herein incorporated by reference for all purposes. Responses from CMTS 12 and CM 16 are similarly communicated to hand-held computers 50A and 50B, respectively, via communication links 52A and 52B for display and further processing.
>
> "FIGS. 2A and 2B illustrate the connections 52A or 52B by which the handheld computers 50A or 50B connect to the network equipment such as CMTS 12 or CM 16. In FIG. 2A, connection 52A or 52B is a wireless infrared connection maintained between infra-red ports, such as IrDA ports, present in hand-held computer 50A or 50B and the CMTS12 or CM 16. Other types of wireless connections, such as RF connections (e.g. Bluetooth), can be substituted for the IrDA connection, in which case RF interface ports are installed in the hand-held

computer 50A or 50B and the CMTS 12 or CM 16. Also, the connection 52A or 52B can be a wired RS-232 connection, such as a LAN (local-area network) port or serial port, as is shown in FIG. 2B."

Budinger, col. 6, line 59-col. 7, line 20. Thus it is clear that in Budinger, handheld computer 50A communicates only with Cable Modem Termination System 12, not with the CATV network, and handheld computer 50B communicates only with Cable Modem 16, not with the CATV network.

In Chappell,

"The testing services headend 26 is coupled to the CATV distribution network 30 via the signal combiner 28 in order to apply various testing signals to the CATV distribution network 30 and transmit forward telemetry messages to the field clients 50_1 and 50_2. Moreover, the testing services headend 26 is coupled to the nodes 31_1, 31_2 . . . 31_N in order to receive upstream signals from the subscribers 40 and reverse telemetry messages from the field clients 50_1 and 50_2. In particular, the testing services headend 26 is operable to receive a reverse telemetry message from a field client 50_X which requests that a node 32_Y be tested for ingress, obtain reverse spectrum measurements from upstream signals received from the requested node 32_Y, and transmit a forward telemetry message that includes the reverse spectrum measurements to the field client 50_X.

* * *

"During ingress testing, a technician couples the field client 50_X to the CATV distribution network and enters into the field client 50_X a node identifier N_ID_Y which identifies a node 32_Y to be ingress tested. The field client 50_X then transmits upstream to the headend facility 20 a reverse telemetry message that includes the node identifier N_ID_Y for the node 32_Y. The ingress modem 60 receives the reverse telemetry message via the composite upstream signal of the signal combiner 62 and the test point switch 64 which has already been configured to pass the composite upstream signal through to its signal output 67. The ingress modem 60 obtains the node identifier N_ID_Y from the reverse telemetry message and transmits the node identifier N_ID_Y via the communication link 66 to the node selection input 65 of the test point switch 64. The test point switch 64 in response to receiving the node identifier N_ID_Y operably couples the corresponding signal input 63_Y to the signal output 67 thereby passing the upstream signal of the node 32_Y through to the signal output 67 and the ingress modem 60.

"The ingress modem 60 then performs spectral analysis upon the received upstream signal by taking several signal level

> measurements of the upstream signal at different frequencies. After performing spectral analysis upon the received upstream signal, the ingress modem 60 transmits a forward telemetry message which includes the several signal level measurements to the field client 50_X via the CATV distribution network 30. The field client 50_X receives the forward telemetry message and extracts the signal level measurements therefrom. The field client 50_X then graphically displays the signal level measurements thereby enabling a technician to view the reverse spectrum of the requested node 32_Y. The technician then may make determination from the graphical display of whether the headend facility 20 is receiving upstream ingress signals from the requested node 32_Y."

Chappell, col. 4, lines 46-60 and col. 5, line 62-col. 6, line 29. Thus it is clear that in Chappell, the field client 50_X transmits its location (node) to the ingress modem 60, the ingress modem 60 performs a spectral analysis on a received upstream signal, and results of that analysis are then transmitted to the field client 50_X for display.

Claim 2 has been cancelled without prejudice. Claim 1, from which claims 3-7 and 36 depend either directly or indirectly, has been amended to recite

> "[a]n instrument for testing a CATV network, the instrument including an input port for receiving first information from the network, a computer coupled to the input port for processing the first information received from the network, a user interface permitting a user to create second information for communication over the network, and an RS-232 port for coupling the second information to the network."

As established by the above extensive quotations from Budinger and Chappell, this combination is neither disclosed nor suggested by either of Budinger or Chappell or by any 35 U. S. C. § 103 obvious combination of them.

Claim 25, from which claims 26, 29-33 and 38 depend either directly or indirectly, recites:

> "[a]n instrument for testing a CATV network, the instrument including an input port for receiving first information from the network, a computer coupled to the input port for processing the first information, a user interface permitting a user to create second information for communication over the network, and an ethernet interface for coupling the second information to the network."

Again, as established by the above extensive quotations from Budinger and Chappell, this combination is neither disclosed nor suggested by either of Budinger or Chappell or by any 35 U. S. C. § 103 obvious combination of them.

Claim 34 recites

> "[a]n instrument for testing a CATV network, the instrument including an input port for receiving first information from the network, a computer coupled to the input port for processing the first information received from the network, a user interface permitting a user to create second information for communication over the network, a serial port for coupling the second information to the network, and a Web browser capable of handling internet communication protocols"

Again, as established by the above extensive quotations from Budinger and Chappell, this combination is neither disclosed nor suggested by either of Budinger or Chappell or by any 35 U. S. C. § 103 obvious combination of them.

In view of the arguments stated above, reconsideration of this rejection as it pertains to claims 1, 3-7, 25, 26, 29-34, 36 and 38 is requested as well.

B. Reconsideration of the rejection of claims 8-10 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Budinger, Chappell and Chang U.S. Patent No. 6,891,803 (hereinafter Chang) is respectfully requested.

Chang teaches

> "[d]igital subscriber line (DSL) is a technology that offers a solution to the demand for greater bandwidth. DSL offers data rates that can be substantially higher than that of a conventional telephone modem. Furthermore, DSL uses existing twisted copper pair lines that are deployed and prevalent throughout the world. DSL delivers a basic rate access of 128 Kbps (i.e., the ISDN rate). High speed digital subscriber line (HDSL), a variant of DSL, delivers a data rate of 1.544 Mbps (T1) in North America and 2.048 Mbps (E1) elsewhere. Asymmetric digital subscriber line (ADSL), another variant of DSL, delivers data rates of 1.5 to 9.0 Mbps on the downstream path and 16 to 640 Kbps on the upstream path. More advanced variants of DSL promise even higher data rates. Collectively, DSL and variants of DSL are referred to as xDSL.
>
> * * *
>
> "FIG. 1 shows a simplified block diagram of a specific embodiment of a digital communications network 100. Network 100 includes a central office 110 operatively coupled to a personal computer (PC) 120 through xDSL modems 130 and 132. xDSL modem 130 couples to central office 110 and to a splitter 140*a* through a channel 142. xDSL modem 132 couples to PC 120 and to another splitter 140*b* through a channel 144. Splitters 140*a* and 140*b* are coupled through a local loop 150 composed of one or more wire pairs, or other transmission media. Splitters 140*a* and 140*b* also couple to a public switched telephone network (PSTN) 152 and to a

> telephone 154, respectively, for providing a plain old telephone service (POTS). At the transmitting side, splitter 140 combines the POTS and data service into a signal suitable for transmission over local loop 150. At the receiving side, the other splitter 140 separates the received signal into the (lower frequency) voice telephone service and the (higher frequency) data service. In this manner, both voice and data can be transmitted over the same local loop concurrently without any modification to that loop.
>
> "The test set of the invention can be used to test a wide variety of communications networks, including network 100. As used herein, "communications network" generically (and broadly) refers to any structure that supports a digital service carrier using any transmission technology. The transmission technologies covered by the test set of the invention includes plain old telephone system (POTS) modem, E1, T1, Integrated Services Digital Network (ISDN), Digital Subscriber Line (DSL), High data rate DSL (HDSL), Asynchronous DSL (ADSL), Very-high data rate DSL (VDSL), Rate Adaptive DSL (RADSL), Single line DSL (SDSL), and other variants of DSL. DSL and variants of DSL are collectively referred to as xDSL. The test set of the invention can also be adopted to cover transmission technologies such as hybrid fiber coax (HFC), coaxial cable, optical fiber, and others. In a specific application, the test set of the invention is especially suited for testing communications networks implemented using one or more twisted wire pairs."
>
> Claim 8 recites
>
> "[a]n instrument for testing a CATV network, the instrument including an input port for receiving first information from the network, a computer coupled to the input port for processing the first information received from the network, a user interface permitting a user to create second information for communication over the network, a serial port for coupling the second information to the network, and an audio transducer coupled to the computer for producing audio signals in response to third information received from the computer."

Again, as established by the above extensive quotations from Budinger and Chappell, this combination is neither disclosed nor suggested by either of Budinger or Chappell or by any 35 U. S. C. § 103 obvious combination of them. Nor is there any disclosure or suggestion of the desirability of combining any teaching of Chang with any of the teachings of Budinger, Chappell or the Budinger/Chappell combination.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That knowledge can not come from the applicant's invention itself. In re Oetiker, 977 F.2d at 1447, citing Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); In re Geiger, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985).

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

> [V]irtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 U.S.P.Q. 8, 12 (Fed.Cir.1983) ("Most, if not all, inventions are combinations and mostly of old elements."). An examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability.

In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998), citing Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ.2d 1551, 1554 (Fed. Cir. 1996).

The Federal Circuit has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In re Rouffet, 149 F.3d at 1357. The factual inquiry whether to combine references must be thorough and searching. In re Lee, 61 USPQ.2d at 1533. Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The examiner must explain the reasons one of ordinary skill in the art

would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 149 F.3d at 1359, 47 USPQ2d at 1459.

> It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

In re Lee, 61 USPQ2d at 1435.

The nature of the problem that the present invention addresses is the provision of a versatile CATV test instrument which permits the operator to program instructions about how the various tests of the operator's CATV system are to be conducted. The instrument is programmed to accept a scripting language, which permits the operator to customize the instrument's operation using a relatively simple programming language. The instrument is capable of conducting group delay measurements. The instrument is capable of conducting time domain reflectometry measurements. The instrument is capable of digitizing audio, such as, for example, voice communication, and sending the digitized audio both upstream and downstream in the CATV system. The instrument provides the capability to analyze different types of digital modulation. The instrument may be provided with a mobile mount which provides antenna connection, power connection, an interface to, for example, a Global Positioning System (GPS) for establishing location, and a PCS for transmitting, for example, work orders. The instrument obtains information from an information source on the CATV network and displays that information to the technician. Examples of such information include: (1) measurement or status data for some element in the CATV system including third party devices or systems; (2) data from data sources connected to the CATV network. The technician can then modify the data and send the modified data to the originating element or to a second element in the CATV system. The instrument can cause another system or device on the CATV network to take an action, for example, by causing a standby power supply management system on the CATV network to put a particular supply into standby mode. The instrument can receive instructions from some other system or device on the CATV network, causing the instrument to take some action, for example, to take measurements and report them. The instrument can be coupled to the CATV network using a proprietary data carrier, DOCSIS modem, or by means independent of the broadband network, such as a PCS data radio or like wireless data link. The instrument can also be

coupled by direct ethernet connection to a network, such as a LAN. The instrument can communicate directly with third party equipment, such as a third party server. Alternatively, a server can be provided specifically for communication with the instrument. Such a server can also be connected to the broadband network. Such a server can interface with any desired equipment or server. The instrument permits two-way communication, which makes electronic messaging possible. The instrument employs proprietary carriers to achieve electronic messaging. This permits dispatching, uploading and downloading of work orders and performance verification data. It also makes possible e-mail communication. The instrument provides an ethernet interface, which permits the instrument to exist as an entity on a network. This, in turn, permits the instrument to be addressed and interrogated. The instrument can be coupled to a high speed modem. The instrument includes an internet browser which permits it to interact with, for example, a CATV system operator's website, for example, for downloading work orders and transferring of data using, for example, file transfer protocol. The instrument includes a signature pad which permits CATV system subscribers, for example, to sign for installation and service of their terminal equipment. The instrument includes a bar code scanner which permits the user to enter the bar codes of equipment with which the network is provided, or with which it interfaces, for CATV system records, work orders, and the like. See the application as filed, page 11, line 29-page 14, line 16.

In Budinger, handheld computer 50A communicates only with Cable Modem Termination System 12, and handheld computer 50B communicates only with Cable Modem 16. In Chappell, the field client 50_X transmits its location (node) to the ingress modem 60, the ingress modem 60 performs a spectral analysis on a received upstream signal, and results of that analysis are then transmitted to the field client 50_X for display. In Chang, a test set is provided for testing telephone system modems, E1, T1, Integrated Services Digital Network (ISDN), Digital Subscriber Line (DSL), High data rate DSL (HDSL), Asynchronous DSL (ADSL), Very-high data rate DSL (VDSL), Rate Adaptive DSL (RADSL), Single line DSL (SDSL), and other variants of DSL.

Thus, none of Budinger, Chappell or Chang, nor any 35 U. S. C. § 103 obvious combination of them, discloses or suggests any motivation to combine their teachings to provide a highly flexible CATV test instrument. There is no reason why a skilled artisan, without knowledge of the present invention, would have linked Budinger, Chappell and Chang as the focus of the 35 U. S. C. § 103 obviousness inquiry, or combined the three as the Examiner has. The only source linking Budinger, Chappell and Chang to the

present invention is the present application. It is reasonable to infer that the Examiner selected these references with the assistance of hindsight based on Applicants' claims. Courts forbid the use of this kind of hindsight reconstruction in the selection of references to establish 35 U. S. C. § 103 obviousness. In re Rouffet, 149 F.3d at 1358. See In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Lacking a motivation to combine references, the Examiner did not establish a *prima facie* case of obviousness.

To summarize, there is no disclosure or suggestion in Budinger, Chappell and Chang of the desirability of combining their teachings.

Claims 9 and 10 depend either directly or indirectly from claim 8 and are allowable at least for the reasons discussed above in regards to claim 1.

C. Reconsideration of the rejection of claims 14-18, 20, 21 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Ditzik in view of Beriont U. S. Patent 5,479,202 (hereinafter Beriont) is respectfully requested.

Beriont discloses a fiber-ready television receiver. As noted in Beriont,

> "Customers can use the fiber-ready television receivers the same way they use a standard television receiver, but can now access advanced services through the video gateway of multiple networks. The consumer's remote control and an on-screen menu are used to select between services offered from the off-air antenna, cable, the in-home VCR, or the broadband telco fiber network. Once the optical fiber is installed, the fiber-ready receiver can be conveniently transported and connected to the network via a standard ST bulkhead connector mounted on the rear of the receiver."

Beriont, col. 5, lines 21-30. Neither Ditzik nor Beriont, nor any 35 U. S. C. § 103 obvious combination of them, discloses or suggests any motivation to combine their teachings to provide a highly flexible CATV test instrument. There is no reason why a skilled artisan, without knowledge of the present invention, would have linked Ditzik and Beriont as the focus of the 35 U. S. C. § 103 obviousness inquiry, or combined them as the Examiner has. The only source linking Ditzik and Beriont to the present invention is the present application. It is reasonable to infer that the Examiner selected these references with the assistance of hindsight based on Applicants' claims. Again, courts forbid the use of this kind of hindsight reconstruction in the selection of references to establish 35 U. S. C. § 103 obviousness. In re Rouffet, *supra.*; In re Gorman, *supra.* Lacking a motivation to combine references, the Examiner did not establish a *prima facie* case of obviousness.

Claims 14-18, 20, 21 and 37 depend either directly or indirectly from

independent claim 13 and are allowable at least for the reasons discussed above in regards to claim 13.

D. Reconsideration of the rejection of claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Ditzik.

Claims 22-24 depend either directly or indirectly from independent claim 13 and are allowable at least for the reasons discussed above in regards to claim 13.

Allowable Subject Matter

The Examiner has objected to claims 11, 12, 27, and 28 as being dependent upon a rejected base claim, but has indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended claims 11 and 27 to include the limitations of their respective base claims and any intervening claims. Claims 12 and 28 depend from claims 11 and 27, respectively, and are entitled to favorable consideration, culminating in allowance, at least on this basis.

Accordingly, Applicants submit that this application is in condition for further favorable consideration, culminating in allowance. Such action is respectfully requested.

Further Action

In the event that there are any questions related to this amendment or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned. The Examiner is invited to call the undersigned at (317) 231-7285 to discuss any outstanding issues or concerns so that allowance of the present application may be expedited.

Applicants herewith petition for a one month extension of the term for response to October 30, 2005. The Commissioner is hereby authorized to charge the $60.00 fee for this petition, as well as the $200 fee for two additional independent claims (37 claims, 7 independent, less the 41 claims, 5 independent previously paid for), as well as any additional fees which may be due to constitute this a timely response, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435, with reference to our file 6573-68375.

Respectfully submitted,

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